

**To:** The Ohio State University ([ColsTrademarks@fbtlaw.com](mailto:ColsTrademarks@fbtlaw.com))  
**Subject:** U.S. Trademark Application Serial No. 88571984 - THE - 0539066  
**Sent:** September 11, 2019 07:21:42 AM  
**Sent As:** ecom124@uspto.gov  
**Attachments:** [Attachment - 1](#)  
[Attachment - 2](#)  
[Attachment - 3](#)

**United States Patent and Trademark Office (USPTO)**  
**Office Action (Official Letter) About Applicant's Trademark Application**

**U.S. Application Serial No.**  
88571984

**Mark:** THE

**Correspondence Address:**  
SAMANTHA M. QUIMBY  
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COLUMBUS, OH 43215

**Applicant:** The Ohio State  
University

**Reference/Docket No.**  
0539066

**Correspondence Email  
Address:**

[ColsTrademarks@fbtlaw.com](mailto:ColsTrademarks@fbtlaw.com)

**NONFINAL OFFICE ACTION**

The USPTO must receive applicant's response to this letter within six months of the issue date below or the application will be [abandoned](#). Respond using the Trademark Electronic Application System (TEAS). A link to the appropriate TEAS response form appears at the end of this Office action.

**Issue date:** **September 11, 2019**

The referenced application has been reviewed by the assigned trademark examining attorney. Applicant must respond timely and completely to the issues below. 15 U.S.C. §1062(b); 37 C.F.R. §§2.62(a), 2.65(a); TMEP §§711, 718.03.

**SUMMARY OF ISSUES:**

- Advisory – Prior-Filed Application
- Sections 1, 2 and 45 Refusal – Failure to Function – Merely Ornamental

**ADVISORY - PRIOR-FILED APPLICATION**

The filing date of pending U.S. Application Serial No. 88416806 precedes applicant's filing date. See attached referenced application. If the

mark in the referenced application registers, applicant's mark may be refused registration under Trademark Act Section 2(d) because of a likelihood of confusion between the two marks. *See* 15 U.S.C. §1052(d); 37 C.F.R. §2.83; TMEP §§1208 *et seq.*

In response to this Office action, applicant may present arguments in support of registration by addressing the issue of the potential conflict between applicant's mark and the mark in the referenced application. Applicant's election not to submit arguments at this time in no way limits applicant's right to address this issue later if a refusal under Section 2(d) issues.

## **SECTIONS 1, 2 and 45 REFUSAL – FAILURE TO FUNCTION – MERELY ORNAMENTAL**

Registration is refused because the applied-for mark as used on the specimen of record is merely a decorative or ornamental feature of applicant's clothing and, thus, does not function as a trademark to indicate the source of applicant's clothing and to identify and distinguish applicant's clothing from others. Trademark Act Sections 1, 2, and 45, 15 U.S.C. §§1051-1052, 1127; *see In re Lululemon Athletica Can. Inc.*, 105 USPQ2d 1684, 1689 (TTAB 2013); *In re Pro-Line Corp.*, 28 USPQ2d 1141, 1142 (TTAB 1993); TMEP §§904.07(b), 1202.03 *et seq.*

The size, location, dominance, and significance of the alleged mark as used on the goods are all relevant factors in determining the commercial impression of the applied-for mark. *See, e.g., In re Peace Love World Live, LLC*, 127 USPQ2d 1400, 1403 (TTAB 2018) (quoting *In re Hulting*, 107 USPQ2d 1175, 1178 (TTAB 2013)); *In re Lululemon Athletica Can. Inc.*, 105 USPQ2d at 1687 (quoting *In re Right-On Co.*, 87 USPQ2d 1152, 1156 (TTAB 2008)); TMEP §1202.03(a).

With respect to clothing, consumers may recognize small designs or discrete wording as trademarks, rather than as merely ornamental features, when located, for example, on the pocket or breast area of a shirt. *See* TMEP §1202.03(a). Consumers may not, however, perceive larger designs or slogans as trademarks when such matter is prominently displayed across the front of a t-shirt. *See In re Pro-Line Corp.*, 28 USPQ2d at 1142; *In re Dimitri's Inc.*, 9 USPQ2d 1666, 1667-68 (TTAB 1988); TMEP §1202.03(a), (b), (f)(i), (f)(ii).

In this case, the submitted specimen shows the applied-for mark, THE, located directly on the upper-center area of the front of the shirt and the front portion of the hat, where ornamental elements often appear. *See* TMEP §1202.03(a), (b). Furthermore, the mark is displayed in a relatively large size on the clothing such that it dominates the overall appearance of the goods. As such, the applied-for mark appears to be used in a merely decorative manner that would be perceived by consumers as having little or no particular source-identifying significance.

Therefore, consumers would view the applied-for mark as a decorative or ornamental feature of the goods, rather than as a trademark to indicate the source of applicant's goods and to distinguish them from others.

*In appropriate circumstances*, applicant may overcome this refusal by satisfying one of the following options:

- (1) Submit a different specimen (a verified [“substitute” specimen](#)) that was in actual use in commerce at least as early as the filing date of the application (or prior to the filing of an amendment to allege use) and that shows proper trademark use for the identified goods in International Class 25. Examples of acceptable specimens that show non-ornamental use on clothing include hang tags and labels used inside a garment.
- (2) Amend to the [Supplemental Register](#), which is a second trademark register for marks not yet eligible for registration on the Principal Register, but which may become capable over time of functioning as source indicators.
- (3) Claim acquired distinctiveness under Trademark Act Section 2(f) by submitting [evidence](#) that the applied-for mark has become distinctive of applicant's goods; that is, proof that applicant's extensive use and promotion of the mark allowed consumers now directly to associate the mark with applicant as the source of the goods.
- (4) Submit evidence that the applied-for mark is an [indicator of secondary source](#); that is, proof that the mark is already recognized as a source indicator for *other* goods or services that applicant sells/offers.
- (5) Amend the filing basis to [intent to use under Section 1\(b\)](#). This option will later necessitate additional fee(s) and filing requirements.

For an overview of the response options above and instructions on how to satisfy each option online using the Trademark Electronic Application System (TEAS) form, see the [Ornamental Refusal webpage](#).

## **RESPONSE GUIDELINES**

Please call or email the assigned trademark examining attorney with questions about this Office action. Although the trademark examining attorney cannot provide legal advice or statements about applicant's rights, the trademark examining attorney can provide applicant with

additional explanation about the refusal(s) and/or requirement(s) in this Office action. *See* TMEP §§705.02, 709.06. Although the USPTO does not accept emails as responses to Office actions, emails can be used for informal communications and will be included in the application record. *See* 37 C.F.R. §§2.62(c), 2.191; TMEP §§304.01-.02, 709.04-.05.

**TEAS PLUS OR TEAS REDUCED FEE (TEAS RF) APPLICANTS – TO MAINTAIN LOWER FEE, ADDITIONAL REQUIREMENTS MUST BE MET, INCLUDING SUBMITTING DOCUMENTS ONLINE:** Applicants who filed their application online using the lower-fee TEAS Plus or TEAS RF application form must (1) file certain documents online using TEAS, including responses to Office actions (see TMEP §§819.02(b), 820.02(b) for a complete list of these documents); (2) maintain a valid e-mail correspondence address; and (3) agree to receive correspondence from the USPTO by e-mail throughout the prosecution of the application. *See* 37 C.F.R. §§2.22(b), 2.23(b); TMEP §§819, 820. TEAS Plus or TEAS RF applicants who do not meet these requirements must submit an additional processing fee of \$125 per class of goods and/or services. 37 C.F.R. §§2.6(a)(1)(v), 2.22(c), 2.23(c); TMEP §§819.04, 820.04. However, in certain situations, TEAS Plus or TEAS RF applicants may respond to an Office action by authorizing an examiner's amendment by telephone or e-mail without incurring this additional fee.

**How to respond.** [Click to file a response to this nonfinal Office action](#)

/Tara L. Bhupathi/  
Examining Attorney  
Law Office 124  
(571) 272-5557  
tara.bhupathi@uspto.gov

## RESPONSE GUIDANCE

- **Missing the response deadline to this letter will cause the application to [abandon](#).** A response or notice of appeal must be received by the USPTO before midnight **Eastern Time** of the last day of the response period. TEAS and ESTTA maintenance or [unforeseen circumstances](#) could affect an applicant's ability to timely respond.
- **[Responses signed by an unauthorized party](#)** are not accepted and can **cause the application to [abandon](#)**. If applicant does not have an attorney, the response must be signed by the individual applicant, all joint applicants, or someone with [legal authority to bind a juristic applicant](#). If applicant has an attorney, the response must be signed by the attorney.
- If needed, find [contact information for the supervisor](#) of the office or unit listed in the signature block.

**DESIGN MARK**

**Serial Number**

88416806

**Status**

NON-FINAL ACTION - MAILED

**Word Mark**

THE

**Standard Character Mark**

Yes

**Type of Mark**

TRADEMARK

**Register**

PRINCIPAL

**Mark Drawing Code**

(4) STANDARD CHARACTER MARK

**Owner**

Marc Jacobs Trademarks, L.L.C. LIMITED LIABILITY COMPANY DELAWARE 72  
Spring Street New York NEW YORK 10012

**Goods/Services**

Class Status -- ACTIVE. IC 018. US 001 002 003 022 041. G & S:  
Handbags; knapsacks; back packs; rucksacks; tote bags; beach bags;  
carry-all bags; satchels; clutch bags; shoulder bags; sling bags;  
purses; cosmetic bags sold empty; change purses; wallets; leather  
pouches; business card cases; credit card cases; toiletry cases sold  
empty; crossbody bags; traveling bags. First Use: 2018/12/03. First  
Use In Commerce: 2018/12/03.

**Goods/Services**

Class Status -- ACTIVE. IC 025. US 022 039. G & S: Clothing,  
namely, underwear, socks, hosiery, jerseys, shirts, t-shirts, blouses,  
sweaters, cardigan sweaters, pullovers, hoodies, sweatshirts, pants,  
jeans, shorts, dresses, skirts, blazers, jackets, coats, overcoats,  
waterproof clothing, namely, jackets and jumpsuits; bathing suits;  
belts; scarves; shawls; bandanas; waistcoats; pajamas; footwear,  
namely, shoes, boots, sandals and slippers; headwear, namely, hats and  
caps. First Use: 2018/12/03. First Use In Commerce: 2018/12/03.

**Filing Date**

2019/05/06

**Examining Attorney**

CLARKE, AISHA

**Print: Sep 4, 2019**

**88416806**

**Attorney of Record**

Jessica G. Kraver

THE

**To:** The Ohio State University ([ColsTrademarks@fbtlaw.com](mailto:ColsTrademarks@fbtlaw.com))  
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**Attachments:**

**United States Patent and Trademark Office (USPTO)**

**USPTO OFFICIAL NOTICE**

Office Action (Official Letter) has issued  
on **September 11, 2019** for  
**U.S. Trademark Application Serial No. 88571984**

Your trademark application has been reviewed by a trademark examining attorney. As part of that review, the assigned attorney has issued an official letter that you must respond to by the specified deadline or your application will be [abandoned](#). Please follow the steps below.

- (1) [Read the official letter](#).
- (2) **Direct questions** about the contents of the Office action to the assigned attorney below.

/Tara L. Bhupathi/  
Examining Attorney  
Law Office 124  
(571) 272-5557  
[tara.bhupathi@uspto.gov](mailto:tara.bhupathi@uspto.gov)

Direct questions about navigating USPTO electronic forms, the USPTO [website](#), the application process, the status of your application, and/or whether there are outstanding deadlines or documents related to your file to the [Trademark Assistance Center \(TAC\)](#).

- (3) **Respond within 6 months** (or earlier, if required in the Office action) from **September 11, 2019**, using the Trademark Electronic Application System (TEAS). The response must be received by the USPTO before midnight **Eastern Time** of the last day of the response period. See the Office action for more information about how to respond.

**GENERAL GUIDANCE**

- [Check the status](#) of your application periodically in the [Trademark Status & Document Retrieval \(TSDR\)](#) database to avoid missing critical deadlines.
- [Update your correspondence email address](#), if needed, to ensure you receive important USPTO notices about your application.
- [Beware of misleading notices sent by private companies about your application](#). Private companies not associated with the USPTO use public information available in trademark registrations to mail and email trademark-related offers and notices – most of which require fees. All official USPTO correspondence will only be emailed from the domain “@uspto.gov.”